REMARKS

In the Official Action mailed 21 October 2004, the Examiner reviewed claims 1 14. The Examiner rejected claims 1-44. The Examiner rejected claims 1-21 under 35 U.S.C. §101; rejected claims 22, 27, 31, 35 and 37 under 35 U.S.C. §102(e); rejected claim 23 under 35 U.S.C. §103(a); rejected claims 24 and 25 under 35 U.S.C. 103(a); rejected claims 26, 28-30 32-34 and 38 are rejected under 35 U.S.C. §103(a); rejected claim 36 under 35 U.S.C. §103(a); rejected claim 39 under 35 U.S.C. §103(a); appears to be rejecting claim 42 under 35 U.S.C. §103(a); appears to be rejecting claim 44 under U.S.C §103(a); rejected claims 40 and 41 under 35 U.S.C. §103(a); and rejected claim 43 under 35 U.S.C. §103(a).

Applicant has added new claim 45, amended claim 22, and canceled claims 1 21 and 23. Claims 22 and 24-45 remain pending.

Rejection of Claims 1-21 under 35 U.S.C. §101

Claims 1-21 are rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-20 of prior U.S. Patent No. 6,216,158.

Claims 1-21 are canceled.

Accordingly, the rejection of claims 1-21 is moot.

Rejection of Claims 22, 27, 31, 35 and 37 under 35 U.S.C. §102(e)

Claims 22, 27, 31, 35 and 37 are rejected under 35 U.S.C. §102(e) as being unpatentable over Ortony, U.S. Patent No. 6,038,595.

Claim 22 is amended to include the limitations of now canceled dependent claim 23:

"wherein the protocol includes an exchange in which the console

application notifies a particular service in the group of services which will act as

an application host, of a set of services to be invoked"

Because the Examiner rejected claim 23 as being unpatentable over Ortony in view of Blumenau et al., U.S. Patent No. 6,438,595, and claim 22 is amended to include the limitations of now canceled claim 23, applicants discuss here the Ortony and Blumenau references

The Examiner noted that Ortony does not disclose "an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked". The Examiner then relied on Blumenau to disclose the quoted limitation.

The Examiner is mistaken because Blumenau fails to disclose the quoted limitation. In Blumenau, the console application does not notify "a particular service in the group of services which will act as an application host." In contrast with the quoted claim language, the name server of Blumenau does not act as an application host. The Examiner argues "the name server is comparable to an application host as it manages the ports by which the computers in the network can access the other services." However, as the Examiner's own argument indicates, the name server itself is not an "application host." Instead, the name server reports temporary addresses of ports. To provide an analogy, by reporting port addresses, the name server "acts" as any of the services reachable at those port addresses, no more than a telephone operator reporting a telephone number of a hospital "acts" as a doctor.

Even assuming *arguendo* that the name server of Blumenau "acts" as an application host, Blumenau fails to teach a particular service in a "group of services" as claimed. Examples of services that might be in a "group of services" are mentioned in dependent claims as follows: a slide presentation program, an email client program, a calendar program, a user interface program for a networked appliance, a print service, a fax service, an internet browser service, a language and/or speech translation service, and a conference room reservation function. Instead of notifying a particular service in the "group of services" as claimed, Blumenau is about connecting a host to storage. Blumenau does not discuss a "group of services" as claimed; Blumenau only discusses one service, namely that of connecting to storage.

Accordingly, the combination of Ortony and Blumenau et al. does not include all limitations in claim 22 as amended, and therefore does not satisfy the basic requirement for a *prima facie* case of obviousness.

Claims 27, 31, 35 and 37 depend from claim 22 as amended, and are allowable for at least the same reasons.

Therefore, withdrawal of the rejection of claims 22, 27, 31, 35, and 37 is respectfully requested.

Rejection of Claim 23 under 35 U.S.C. §103(a)

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ortony in view of Blumenau et al., U.S. Patent No. 6,438,595.

Claim 23 is canceled. Accordingly, the rejection of claims 23 is moot.

Rejection of Claims 24 and 25 under 35 U.S.C. §103(a)

Claims 24 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable ▪▪▪r Ortony, in view of Orenshteyn, U.S. Patent No. 5,889,942.

Claims 24 and 25 depend from claim 22 as amended.

The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Ortony and Orenshteyn fails to disclose the following language of claim 22 as amended:

> "wherein the protocol includes an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked"

Accordingly, reconsideration of the rejection of claims 24 and 25 is respectfully requested.

Rejection of Claims 26. 28-30, 32-34 and 38 under 35 U.S.C. §103(a)

Claims 26, 28-30, 32-34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ortony and Orenshteyn, in further view of an Official Notice.

Claims 26, 28-30, 32-34 and 38 depend from claim 22 as amended.

The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Ortony and Orenshteyn fails to disclose the following language of claim 22 as amended:

> "wherein the protocol includes an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked"

Accordingly, reconsideration of the rejection of claims 26, 28-30, 32-34 and 38 is respectfully requested.

Rejection of Claim 36 under 35 U.S.C. §103(a)

Claim 36 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ortony and Orenshteyn, in further view of Whitehead, et al., U.S. Patent No. 6,085,030.

Claim 36 depends from claim 22 as amended.

The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Ortony and Orenshteyn fails to disclose the following language of claim 22 as amended:

> "wherein the protocol includes an exchange in which the console application notifies a particular service in the group of services which will act as an application host, of a set of services to be invoked"

Accordingly, reconsideration of the rejection of claim 36 is respectfully requested.

Rejection of Claim 39 under 35 U.S.C. §103(a)

Claim 39 is rejected under 35 U.S.C. §103(a) as being unpatentable over Frese II et al., U.S. Patent No. 5,909,545 ["Frese"], in view of Ortony.

Claim 39 includes the limitation of a "portable computing platform."

The Examiner notes that Frese does not disclose a "portable" computing platform. Ortony also fails to disclose a "portable" computing platform. Consequently, the rejection does not satisfy the basic requirement for a *prima facie* case of obviousness.

The "portable" nature of the computing platform is advantageous because it permits the invention as claimed to be used in a mobile context. For example, the location of the user can change, as discussed in page 4 of the application. The "portable" limitation is significant because the size of a computing platform is strongly correlated with its processing abilities. For example, a mainframe computing platform tends to have more processing resources than a desktop computing platform, and a desktop computing platform tends to have more processing resources than a "portable" computing platform. In the context of the claim language, the "portable" limitation is particularly significant because the "portable computing platform" sidesteps its relatively limited processing resources by controlling an "application" that executes on another "processor," rather than controlling an application which executes on the portable computing platform" itself. Precisely because a "portable" computing platform has historically suffered from weakly powered processing resources compared to larger desktop and mainframe computing platforms, the invention as claimed in claim 39 with a "portable" computing platform is novel and nonobvious.

To emphasize the significance of the "portable" limitation, an additional dependent claim is added herein, specifying that the "portable computing platform" is a "palm sized"

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Accordingly, reconsideration of the rejection of claim 39 as amended is respectfully requested.

Apparent Rejection of Claim 42 under 35 U.S.C. §103(a)

Although it is not clear from the Office Action, it appears that the Examiner is rejecting claim 42 in the same manner as claim 39.

Claim 42 depends from claim 39, which includes the limitation of a "portable computing platform."

The Examiner notes that Frese does not disclose a "portable" computing platform. Ortony also fails to disclose a "portable" computing platform. The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Frese and Ortony fails to disclose a "portable" computing platform.

Accordingly, reconsideration of the rejection of claim 42 is respectfully requested.

Apparent Rejection of Claim 44 under 35 U.S.C. §103(a)

Although it is not clear from the Office Action, it appears that the Examiner is rejecting claim 44 in the same manner as claim 39.

Claim 44 depends from claim 39, which includes the limitation of a "portable computing platform."

The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Frese and Ortony fails to disclose a "portable" computing platform.

Accordingly, reconsideration of the rejection of claim 44 is respectfully requested.

Rejection of Claims 40 and 41 under 35 U.S.C. §103(a)

Claims 40 and 41 are rejected under 35 U.S.C. §103(a) as being unpatentable over Frese and Ortony, in further view of Myers et al., "Collaboration Using Multiple PDAs connected to a PC" ["Myers"].

Claims 40 and 41 depend from claim 39.

Frese fails to disclose establishing a communication link with a "portable computing platform" and transferring a control program to the "portable computing platform." There would be no motivation to add a "portable computing platform" such as the PalmPilot in M cis,

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because Frese specifies that the device which receives the control program, and establishes a communication link with an application, is implemented by a device that is beyond the capabilities of the PalmPilot described by Myers. In particular, Frese explains at column 7, lines 1-16 that the device implements an operating system such as DOS, DOS with Windows, Windows 95, Unix, OS/2, or an Apple operating system, and even runs a browser program. In contrast with the device of Frese, Myers describes on page 3 the PalmPilot's "limitations" as having "a fairly slow processor" and on page 6 explains that the PalmPilot application compares unfavorably to a desktop computer, being limited to emulating only the regular mouse and keyboard of a desktop computer which runs an operating system such as DOS, etc. Thus, the PalmPilot of Myers which is described as being limited to emulating keystrokes and a mouse, and unable to run a full fledged desktop operating system and browser program, could not be combined with the data system of Frese to supply the "portable computing platform" missing from Frese.

Accordingly, reconsideration of the rejection of claims 40 and 41 as amended is respectfully requested.

Rejection of Claim 43 under 35 U.S.C. §103(a)

Claim 43 is rejected under 35 U.S.C. §103(a) as being unpatentable over Frese and Ortony, in further view of Whitehead.

Claim 43 depends from claim 39, which includes the limitation of a "portable computing platform."

The rejection does not satisfy the basic requirement for a *prima facie* case of obviousness, because the combination of Frese, Ortony, and Whitehead fails to disclose a "portable" computing platform.

Accordingly, reconsideration of the rejection of claim 43 is respectfully requested.

CONCLUSION

It is respectfully submitted that this application is now in condition for allowance, and such action is requested.
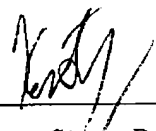
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    The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (3COM 2257-2).

                                    Respectfully submitted,

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